



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,397	12/21/2001	Matthew A. Hayduk	42390P12402	1097

8791 7590 05/15/2006

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

COFFY, EMMANUEL

ART UNIT PAPER NUMBER

2157

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,397

Applicant(s)

HAYDUK, MATTHEW A.

Examiner

Emmanuel Coffy

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-30 and 32-38 is/are rejected.
- 7) ☒ Claim(s) 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 April 2006 has been entered. Claims 1-19 are pending. Claims 1-19 are directed to a device, method and article for a "Portable Computing Device Having a Dynamic Client Classmark & Method Therefor."

Claims 1-2, 5-6, 8-14 and 16-19 are cancelled and new claims 20-38 are added.

Response to Arguments

2. Applicant's arguments revolve around the following central issue that Roel-Ng does not teach or suggest, dynamically generating classmark information. In contrasting Applicant's invention with the prior art, Applicant states that the client classmark claimed in Applicant's claims is used by the client applications/operating systems running on the mobile device itself so that the execution of these applications or functionality available for those applications may be altered or scaled to balance performance traits. See Remarks page 7, 2nd paragraph.

Applicant's arguments have been fully considered and although persuasive, the claims however are rejected for the following reasons.

a. dynamically generating classmark information is obvious. See Gosling et al. (US 6,405,241) col. 3, lines 20-45;

b. The language "the client applications/operating systems running on the mobile device itself so that the execution of these applications or functionality available for those applications may be altered or scaled to balance performance traits" is not clearly incorporated in any claims that the Examiner can ascertain.

c. Claim 21 is taken as an example to illustrate the objections. However, the rationale is applicable to any claims in the same class as 21. The objections follow.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The subject matter not clearly described in the spec includes "device is further adapted to communicate using at a first and second communication service".

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte*

Hasche, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 21 recites the broad recitation "using at a first and second communication service" and the claim also recites " at least in part, on availability of the first and second communication service" which is the narrower statement of the range/limitation. For purposes of examination, the two communication services chosen are: "location area and data rate."

7. Claim 21 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

8. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A reasonable artisan skilled in the art could not comprehend the claims as written. Claim 26 recites: "... includes updating a client classmark for the device based upon the physical capabilities of the device" The physical capabilities are undefined within the claim language. It is not clear what the boundary of the claim is. Hence, the scope of the claim is unascertainable.

However, in order to expedite a more complete examination the Examiner asserts that this recitation is understood as: "hardware capacity." Any other claim which incorporates the same recitation is also rejected by the same rationale.

9. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A reasonable artisan skilled in the art could not comprehend the claims as written. Claim 27 recites: "... includes updating a client classmark for the device based upon the logical capabilities of the device" The logical capabilities are undefined within the claim language. It is not clear what the boundary of the claim is. Hence, the scope of the claim is unascertainable.

However, in order to expedite a more complete examination the Examiner asserts that this invention is understood as: "on-board software."

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 25 is rejected under 35 U.S.C. §102(b) as being anticipated by Roel-Ng et al. (US 6,002,936).

Roel teaches the invention including a telecommunications system and method for allowing a cellular network to determine the optimum positioning method, having knowledge of all available network-based and terminal-based positioning methods. (See abstract)

Claim 25:

Roel substantially teaches a method comprising:
determining what communication services are available to a mobile device; and (See col. 5, lines 29-49)(determining the optimum positioning and quality of service)
updating a client classmark for the mobile device based upon what communication services are available, wherein the client classmark is to be used by one or more client applications executed in the mobile device to determine one or more current attributes of the mobile device (See Fig. 1 index (10, 12, 18, 25), col. 4, line 65- col. 4, line 14).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 20, 21, 24 and 30 are rejected under 35 U.S.C. §103(a) as being unpatentable over Roel-Ng et al. (US 6,002,936) in view of Gosling et al. (US 6,405,241).

Claim 20:

Roel substantially teaches a mobile computing device comprising:

a processor; and (See Fig. 3 index (300) inherently includes a processor)

a memory, wherein the mobile computing device is adapted to dynamically generate a client classmark as the mobile computing device is moved. (See Fig. 3 indices (300, 310) device 300 inherently includes memory – See also col. 4, line 60-col. 5, line 14).

Roel doesnot specifically teach “dynamic generation of information”. However, Gosling does. See col. 3, lines 20-45. Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the mobile device taught by Roel-Ng with dynamically generating information disclosed by Gosling. Such system would dynamically generate information upon execution of an application rather than incurring a process start-up expense while generating the dynamic information.

Claim 21:

Roel teaches the mobile computing device of claim 20, wherein the mobile computing device is further adapted to communicate using at a first and second communication service, the client classmark being generated depending, at least in part, on availability of the first and second communication service. (See Fig. 1 (10, 12, 18, 25), col. 4, line 41-59.)

Claim 24:

Roel teaches the mobile computing device of claim 20, wherein the memory is adapted to store the client classmark. (See Fig. 3 index (310), col. 5, lines 1-14). It is inherent that the client classmark is stored in memory.)

Claim 30

Roel teaches the method of claim 25, further comprising:
adjusting the execution of an application on a processor in the device depending on the client classmark. (See col. 4, line 60-col. 5, line 14.)

Claim 31:

The method of claim 25, further comprising:

Requesting with a first application executing on a processor in the mobile device that a second application executing on the processor modify its operational characteristics.

This claim is objected to for depending upon a rejected claim.

Claim 32:

Roel teaches the mobile computing device of claim 25, further comprising storing the client classmark in a memory of the mobile device. (See Fig. 3 index (310), col. 5, lines 1-14). It is inherent that the client classmark is stored in memory.)

14. Claims 22, 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Roel-Ng et al. (US 6,002,936) in view of Gosling et al. (US 6,405,241) in further view of Sekizawa et al. (US 5,410,651).

Claim 22

Roel teaches the mobile computing device of claim 20 as discussed above. Both Roel-Ng and Gosling are silent as to "a monitor adapted to track a load status of the processor, wherein the client classmark is generated at least in part based on the load status of the processor."

However, Sekizawa does. See col. 1, lines 64-66; col. 3, lines 55-66; and col. 7, lines 10-41 **particularly lines 10-12, 25-29 and 38-42**. Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Roel-Ng and Gosling with the program loading method of Sekizawa. Such system would greatly improve the situation when a processor undergoes a concentrated load where the rapidity of a series of processes is reduced.

Claim 23

Roel teaches the mobile computing device of claim 20 as discussed above. Both Roel-Ng and Gosling are silent as to “a monitor adapted to track a load status of the processor, wherein the client classmark is generated at least in part based on the load status of the processor.” However, Sekizawa does. See col. 1, lines 64-66; col. 3, lines 55-66; and col. 7, lines 10-41 **particularly lines 10-12, 25-29 and 38-42**. Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Roel-Ng and Gosling with the program loading method of Sekizawa. Such system would greatly improve the situation when a processor undergoes a concentrated load where the rapidity of a series of processes is reduced.

15. Claims 26 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Roel-Ng et al. (US 6,002,936) in view of Rawson III (US 6,480,966.)

Claim 26:

Roel-Ng teaches the method of claim 25 as discussed above. Roel-Ng does not specifically teach: polling to determine the hardware capacity of the device, wherein updating the client classmark includes updating the client classmark for the mobile device based upon the hardware capacity of the device. (The performance monitor indicates the hardware capacity of the device.)

However, Rawson explicitly teaches this limitation throughout specifically at col. 4, lines 25-30.

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the use of mobile device taught by Roel-Ng with the performance monitor as taught by Rawson because performance counters permit processor performance parameters to be monitored and measured where the information obtained from these counters can then be used for tuning system performance.

Claim 29:

Roel-Ng teaches the method of claim 25 as discussed above. Roel-Ng does not specifically teach: determining a current load of a processor in the mobile device, wherein updating the client classmark includes updating the client classmark for the device based upon the current load of the processor.

Roel-Ng does not specifically teach determining a current load or performance status. However, Rawson explicitly teaches this limitation throughout specifically at col. 4, lines 25-30.

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the use of mobile device taught by Roel-Ng with the performance monitor as taught by Rawson because performance counters would permit processor's performance parameters to be monitored and measured where the information obtained from these counters can then be used for tuning system performance.

16. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roel-Ng et al. (US 6,002,936) in view of Koehne, Leif EP 0 980 190 A1.)

Claim 27:

Roel-Ng teaches the method of claim 25 as discussed above. Roel-Ng does not specifically teach: polling to determine logical capabilities of the device, wherein updating the client

classmark includes updating the client classmark for the device based upon on-board software of the device.

However, Koehne explicitly teaches available modes of operation at paragraph 0043.
(the modes of operation supported are directly related to on-board software.)

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the use of mobile device taught by Roel-Ng with the available modes of operation as taught by Koehne because on-board software determines the modes of operation by limiting the services that can be accessed.

Claim 28:

Roel-Ng teaches the method of claim 25 as discussed above. Roel-Ng does not specifically teach: defining user preferences, wherein maintaining the client classmark includes maintaining a client classmark for the device based upon the user preferences.

However, Koehne explicitly teaches user preferences at paragraphs 0043 and 0056.
Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the use of mobile device taught by Roel-Ng with the user preferences as taught by Koehne because user preferences would be used to provide a specific service.

17. Claims 33-36 and 38 directed to an article are rejected under 35 USC 103(a) as being unpatentable over Koehne (EP 0 980 190 A1 in view of Purpura (US 6,973,518)).

Claim 33:

Koehne substantially teaches an article comprising a storage medium having stored thereon instructions, that, when executed by a computing platform, results in:
dynamically generating a client classmark for the article based upon what communication services are available, wherein the client classmark is configured to be used by one or more client applications on a mobile device to determine capabilities of the mobile device. (See

paragraphs 0043-0057)

Koehne is silent as to “polling to determine one or more hardware capabilities of the device, wherein the client classmark is configured to be used by one or more indicators about the one or more hardware capabilities of the device.” However, Purpura does disclose said limitation. See col. 9, lines 35-39 and col. 11, lines 20-23. Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Koehne with the mobile apparatus for configuring portable devices as taught by Purpura. Such system would provide for hardware and software configuration of different devices.

Claim 34:

Koehne substantially teaches the article of claim 33 as discussed above. Koehne is silent as to “polling to determine one or more hardware capabilities of the device,...” However, Purpura does disclose said limitation. See col. 9, lines 35-39 and col. 11, lines 20-23. Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Koehne with the mobile apparatus for configuring portable devices as taught by Purpura. Such system would provide for hardware and software configuration of different devices.

Claim 35:

Koehne substantially teaches the article of claim 33 as discussed above, wherein the instructions, when executed, further result in:

polling to determine logical capabilities of the article, wherein dynamically generating the client classmark includes generating a client classmark for the article based upon the logical capabilities of the mobile device. Koehne explicitly teaches available modes of operation at paragraph 0043. (the modes of operation supported are directly related to on-board software and also see paragraphs 0043-0057.)

Claim 36:

Koehne substantially teaches the article of claim 33 as discussed above, wherein the instructions, when executed, further result in:

Allowing a user to define preferences for the mobile device, wherein dynamically generating the client classmark includes generating a client classmark for the article based upon the user-defined preferences. (See paragraphs 0043-0056).

Claim 38:

Koehne substantially teaches the article of claim 33 as discussed above, wherein the instructions, when executed, further result in:

Adjusting execution of an application on a processor in the mobile device depending the client classmark. (See paragraphs 0043-0057).

18. Claim 37 is rejected under 35 USC 103(a) as being unpatentable over Koehne (EP 0 980 190 A1 in view of Purpura (US 6,973,518) in further view of Rawson III (US 6,480,966).

Claim 37:

Koehne substantially teaches the article of claim 33 as discussed above. Both Koehne and Purpura are silent as to:

determining a current load of a processor in the mobile device, wherein updating the client classmark includes updating the client classmark for the device based upon the current load of the processor.

However, Rawson explicitly teaches this limitation throughout specifically at col. 4, lines 25-30. Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Koehne and Purpura with the performance monitor as taught by Rawson because performance counters would permit processor's performance parameters to be monitored and measured where the information obtained from

Art Unit: 2157

these counters would then be used for tuning system performance.

CONCLUSION


19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Coffy whose telephone number is (571) 272-3997. The examiner can normally be reached on 8:30 - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Emmanuel Coffy
Patent Examiner
Art Unit 2157

EC
May 1, 2006


ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
EBC CENTER 2100